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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,320	04/27/1999	JOHN ANDREW COOK	AT9-99-159	4309
35525	7590	11/04/2003	EXAMINER	
DUKE W. YEE CARSTENS, YEE & CAHOON, L.L.P. P.O. BOX 802334 DALLAS, TX 75380			HOOSAIN, ALLAN	
		ART UNIT		PAPER NUMBER
		2645		17
DATE MAILED: 11/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/300,320	COOK ET AL.
Examiner	Art Unit	
Allan Hoosain	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on Appeal Brief, 5/28/03.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7, 10-22 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s)       is/are withdrawn from consideration.
- 5) Claim(s)       is/are allowed.
- 6) Claim(s) 1-7, 10-22 and 25-33 is/are rejected.
- 7) Claim(s)       is/are objected to.
- 8) Claim(s)       are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on       is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on       is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No.      .  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                         | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>     </u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>     </u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Reopening of Prosecution**

1. In view of the Appeal Brief filed on 5/28/03, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Objections***

2. Claims 11-12 are objected to because of the following informalities: Claim 11 depends on Claim 12 and Claim 12 depends on Claim 10. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 10-22, 25-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Logan et al.** (US 5,721,827).

As to claims 1,16, with respect to Figures 1 and 5-7, **Logan** teaches a method in a data processing system for processing voice messages, the method comprising the data processing system implemented steps of:

recording a comment (voice message) (Col. 40, lines 43-63);  
responsive to recording of the comment (voice message), automatically inserting program ID data (an indicator) into a file (text message) indicating a presence of a voice message (Col. 14, lines 42-67 and Col. 40, lines 46-55);  
responsive to recording the comment (voice message), automatically appending the comment (voice message) to the file (text message) to form an appended voice message (Col. 40, lines 59-60); and  
uploading (sending) the file (text message) with the appended voice message (Col. 41, lines 2-7).

As to Claims 2,17, **Logan** teaches the method of claim 1 further comprising:

receiving the file (text message) to form a received text message (Col. 31, lines 53-60);  
parsing the received file (text message) for a presence of a program ID (an indicator) indicating that the received text message is a voice message (Col. 31, lines 53-60); and

responsive to a presence of the indicator, presenting controls to listen to the voice message (Col. 12, lines 32-42 and Col. 31, lines 53-60).

As to Claims 3, 18 and 27, **Logan** teaches the method of claim 1, wherein the received text message is an electronic mail message (Col. 42, lines 16-18).

As to claims 4,19, **Logan** teaches the method of claim 1, wherein the indicator is a topic description (text string) (Col. 41, lines 24-30).

As to Claims 5-7 and 20-22, **Logan** teaches the method of claim 1, wherein the data processing system is a personal computer (Col. 3, lines 1-5).

As to Claim 32, **Logan** teaches the method of claim 1, wherein the step of automatically inserting an indicator into a text message comprises inserting the indicator into a body of the text message (Col. 41, lines 46-51).

As to Claim 33, **Logan** teaches the data processing system of claim 16, wherein the inserting means comprises means for inserting the indicator into a body of the text message (Col. 41, lines 46-51).

As to Claims 10,31, with respect to Figures 1 and 5-7, **Logan** teaches a method in a computer for receiving messages, the method comprising:

receiving a program record (first text message) including a custom message of a first type (Col. 31, lines 22-36);

parsing the first text message for markers (an identifying string) identifying a presence of a custom message associated with the first text message (Col. 31, lines 22-36); and

responsive to the presence of the identifying string and responsive to selection of the text message, identifying the first type and presenting first controls to access the first custom message (Col. 10, lines 51-55 and Col. 31, lines 22-36);

receiving a bookmark (second text message) including a comment (second custom message) of a second type (Col. 10, lines 51-55 and Col. 31, lines 51-56);

parsing the second text message for an identifying string identifying a presence of a custom message (Col. 11, lines 26-35 and Col. 31, lines 51-57); and

responsive to a presence of an identifying string in the second message, identifying the second type and presenting second controls to access the second custom message (Col. 11, lines 26-35 and Col. 31, lines 56-60).

As to Claims 11,26, **Logan** teaches the method of claim 12 wherein the first controls comprise controls for presenting the voice message (Col. 11, lines 26-35).

As to Claim 12, **Logan** teaches the method of claim 10, wherein the first custom message is a voice message and the second custom message is a stock trade (Col. 31, lines 27-30 and Col. 37, lines 26-35).

As to Claims 13,28, **Logan** teaches the method of claim 12, wherein the first controls include a play control, back (a rewind control), and skip (a fast forward control) (Col. 14, lines 28-41).

As to Claims 14,29, with respect to Figures 1 and 5-7, **Logan** teaches a messaging system for use in a data processing system, the messaging system comprising:

a graphical user interface, wherein the graphical user interface provides selections for user input to create and send comments (voice messages) (Col. 14, line 64 through Col. 15, line 6 and Col. 40, lines 55-58); and

a message processing mechanism, wherein the message processing mechanism has a plurality of modes of operation including:

a first mode of operation in which the message processing mechanism waits for a user input (Col. 12, lines 16-24 and Col. 40, lines 22-32);

a second mode of operation, responsive to a user input in the first mode of operation to record a voice message, in which the message processing mechanism stores voice data in a file (Col. 12, lines 24-38 and Col. 40, lines 45-55);

a third mode of operation, responsive to a user input in the first mode of operation to select a recipient for the voice message, in which the message processing mechanism receives a selection of a recipient for the voice message (Col. 12, lines 32-38 and Col. 40, line 64 through Col. 41, line 7); and

a fourth mode of operation, responsive to a user input in the first mode of operation to send the voice message and to a presence of a recipient for the voice message, in which the message processing mechanism creates a comment (a text message), inserts program ID data (an

identifying string), identifies a presence of the voice message in the file (text message), appends the file to the text message, and sends the comment (text message) to the recipient (Col. 14, line 56 through Col. 15, line 12 and Col. 42, lines 1-20).

As to Claims 15,30, **Logan** teaches the messaging system of claim 14, wherein the message processing mechanism further includes:

a fifth mode of operation in which the message processing mechanism waits for a receipt of a text message (Col. 31, lines 44-50);

a sixth mode of operation, responsive to receiving a text message, in which the message processing mechanism parses the text message to determine whether an identifying string identifying a presence of a voice message is present (Col. 31, lines 50-60); and

a seventh mode of operation, responsive to a presence of the identifying string, in which the message processing mechanism causes the graphical user interface to display the message as a voice message in a message list (Col. 31, lines 44-56 and Col. 41, lines 46-51).

As to Claim 25, with respect to Figures 1 and 5-7, **Logan** teaches a data processing system for receiving messages, the data processing system comprising:

first receiving means for receiving a first text message including a first custom message of a first type (Col. 31, lines 22-37);

first parsing means for parsing the first text message for markers (an identifying string) identifying a presence of a custom message associated with the first text message (Col. 31, lines 27-30);

first displaying means, responsive to the presence of an identifying string in the first text message, for identifying the first type and presenting first controls to access the first custom message (Col. 31, lines 30-37);

second receiving means for receiving a second text message including a second custom message of a second type (Col. 31, lines 51-56);

second parsing means for parsing the second text message for markers (an identifying string) identifying a presence of a custom message (Col. 31, lines 51-56); and

second interface means, responsive to a presence of an identifying string in the second message, for identifying the second type and presenting second controls to access the second custom message (Col. 31, lines 56-60).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1,3,5-6,32,16,19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lung et al.** (US 6,532,230).

As to claims 1,3,5-6,32,16,19-21, with respect to Figures 5-10, **Lung** teaches a method in a data processing system for processing voice messages, the method comprising the data processing system implemented steps of:

recording a voice message (Figure 5, label 610);  
responsive to recording of the voice message, automatically inserting an attachment (an indicator) into an e-mail (text message) indicating a presence of a voice message (Figure 5, label 615);  
responsive to recording the voice message, automatically appending the voice message to the e-mail (text message) to form an appended voice message (Figure 5, label 620); and  
sending the e-mail (text message) with the appended voice message (Figure 10, label 860).

#### *Response to Arguments*

7. Applicant's arguments filed in the 5/28/03 Appeal Brief have been fully considered but they are not persuasive. However, Examiner has reopened prosecution to more clearly cite point out how Logan teaches the limitations and also provided new grounds of rejection.

Examiner also reiterates his invitation to Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hoss et al.** (US 5,951,638) teach an integrated messaging system which stores and delivers messages in different formats.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
Allan Hoosain  
Primary Examiner  
10/20/03